



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/714,953

11/18/2003

Daisuke Fujita

00862.023304.

4539

5514

7590

12/30/2009

FITZPATRICK CELLA HARPER & SCINTO

1290 Avenue of the Americas

NEW YORK, NY 10104-3800

EXAMINER

WILLS, LAWRENCE E

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

12/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/714,953 | Applicant(s) FUJITA ET AL. | |
| | Examiner LAWRENCE E. WILLS | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 15 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-23-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 23, 2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 14, 15, 30, 32, and 33 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. Applicant is advised that should claims 31 be found allowable, claim 33 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 15, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US Patent No. 6,256,662) in view of Blasio (US Patent No. 7,139,094).

Regarding claims 14, 15, 30, 32, and 33 Lo'094 teaches a scanner connection apparatus (130 Fig. 3) which comprising: *a first communication interface* 138 that connects to an image scanning device 144; *a second communication interface* 132 that connects to a control apparatus 102 on a network 120, where the control apparatus 102 has functions of setting a scanning condition (scan-to-file column 8, lines 5-10 or scan-to-application column 8, lines 45-50 is determined by the client 102 and further notice Fig. 10 setting scanner parameters) and of communication with the image scanning device (using the virtual TWAIN driver the application program software the client computer is able to communicate with the image scanning device, column 6, lines 58-65); *a display unit* having a screen that displays an image (Fig. 11 displayed at scanner server); *a selection screen displaying unit* for

Art Unit: 2625

inputting a user instruction and for enabling to issue a scanning start command for the image scanning device (when a user is ready to obtain images, the user requests the scanning operation to begin utilizing the acquire command, Shown in Fig. 9), by: receiving, from the control apparatus via said second communication interface, *a selection image data* (pull down menu illustrated in Fig. 9 graphical user interface) having items to be selected by a user (scanner parameters set in Fig. 10) said display unit displaying the *received selection image data* (based on the scanner parameters sent from the client computer to the server, S476, Fig. 8C, Fig. 11 is displayed at the scanner server); transmitting, via said second communication interface, information specifying an item designated by the user (transmit set scanner parameters acknowledge command, S480), to the control apparatus (from server to client, S480) so that, based on *a scanning start instruction* issued by the user (S492 Fig. 8D, S492 Fig. 8E), a *scanning start command* is output to the image scanning device (document scanned, S492) wherein, said first communication interface, said second communication interface, said virtual driver and the image scanning device connected to the first communication interface configure a unit which operates as a local image scanner of the control apparatus by said processor' s operations (the device driver allows functions such as setting the scanner parameters as if the scanner were directly connected to the client computer, column 13, lines 50-55) of: outputting the scanning start command to the image scanning device via said first communication interface as a

Art Unit: 2625

response to the scanning start instruction by the user (S492 Fig. 8D, user click Start): receiving image data of an original obtained by the image scanning device via said first communication interface (document scanned 492 and store image data file on server 494, Fig. 8E); and transmitting the image data of the original via said second communication interface so that the control apparatus receives the image data of the original (transmit image data file from server to client 496 Fig. 8E), but fails to expressly teach *a touch-sensitive panel* arranged on the screen of the display unit; *and a processor* that controls the scanner connection apparatus.

Blasio'094 teaches scanner connection apparatus (200 Fig. 1) which comprising: *a communication interface* 210 that connects to an image scanning device 100 and a control apparatus 300 on a network 310, *a touch-sensitive panel* (input device 250 Fig. 1, touch screen column 5, lines 55-57) arranged on the screen of the display unit (column 6, lines 1-7); *and a processor* that controls the scanner connection apparatus (controller 200 Fig. 1).

Having a system of Lo'094 reference and then given the well-established teaching of Blasio'094 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the scanner connection system of Lo'094 reference to include the touch sensitive panel on the display unit as taught by Blasio'094 reference, since the result of the combination would have been predictable.

Regarding claim 31, Lo'662 teaches wherein the selection screen displaying unit configured by said display unit provides, to the control apparatus, information specifying plural transmission destinations on the network in which different transmission categories comprised of a facsimile destination, a printer, a FTP destination, a file server, a PC, and a mail destination are included (PC as described in 496, Fig. 8E; FTP column 21, lines 65, I-Fax E-Fax, column 23, line 3) but fail to teach said touch-sensitive panel and said processor.

Blasio'094 teaches scanner connection apparatus (200 Fig. 1) which comprising: *a communication interface* 210 that connects to an image scanning device 100 and a control apparatus 300 on a network 310, *a touch-sensitive panel* (input device 250 Fig. 1, touch screen column 5, lines 55-57) arranged on the screen of the display unit (column 6, lines 1-7); *and a processor* that controls the scanner connection apparatus (controller 200 Fig. 1).

Having a system of Lo'094 reference and then given the well-established teaching of Blasio'094 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the scanner connection system of Lo'094 reference to include the touch sensitive panel on the display unit as taught by Blasio'094 reference, since the result of the combination would have been predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

LEW

Application/Control Number: 10/714,953

Page 8

Art Unit: 2625

December 21, 2009